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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PIETER JAN STAPPERS

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Appeal 2008-0800  
Application 09/879,247<sup>1</sup>  
Technology Center 2100

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Decided: September 30, 2008

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Before JOSEPH L. DIXON, JEAN R. HOMERE, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-8 mailed March 30, 2006, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Application filed June 7, 2001. The real party in interest is Technische Universiteit Delft, Netherlands.



We affirm.

#### A. INVENTION

Appellant invented an electronic database search engine and method for allocating icons to the elements of the database, which icons are displayed at mutual distances that depend on the elements' degree of dissimilarity from initially displayed icons. (Spec., 1:1-13.)

#### B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-8. Claims 1 and 5 are independent claims. Claim 1 is illustrative:

1. An electronic database search engine comprising:
  - an electronic memory device suitable for storing and releasing elements from the database;
  - a display unit;
  - a user interface for selecting and displaying at least one element from the database on the display unit; and
  - control means for controlling the user interface;wherein the user interface allocates icons to the elements of the database, and the icons are suitable for display on the display unit at mutual distances that depend on the elements' degree of dissimilarity, wherein the user interface at initial utilization displays at least some icons on the display unit, wherein the control means selects any arbitrary position on the display unit and depending on the control means, the user interface displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed



elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

### C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Osga	US 5,757,358	May 26, 1998
Tachibana	US 6,219,053 B1	Apr. 17, 2001

John MacCuish et al., *Interactive Layout Mechanisms for Image Database Retrieval*, SPIE, vol. 2656, 104-115 (1996) (MacCuish).

### D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MacCuish in view of Tachibana and further in view of Osga.

### II. PROSECUTION HISTORY

Appellant appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on November 9, 2006. The Examiner mailed an Examiner's Answer (Ans.) on February 7, 2007. Appellant filed a Reply Brief (Reply Br.) on April 9, 2007.



### III. ISSUE

Whether Appellant has shown that the combination of MacCuish, Tachibana, and Osga fails to disclose displaying an icon at any arbitrary position on the display unit.

### IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

#### *Tachibana*

1. Tachibana discloses an icon display method including “a step of drawing an icon indicating an object to be regarded; a step of drawing icons having an equivalent correlation with an object to be regarded at an equal distance from the object to be regarded . . .” (Col. 2, ll. 7-10).

2. Tachibana discloses drawing “an icon corresponding to an object with the correlation with other objects taken into account . . . and computing the positions of the icons having an equivalent correlation with an object to be regarded at an equal distance from the object . . .” (Col. 2, ll. 23-30).

#### *Osga*

3. Osga discloses “a method and apparatus for enhancing a computer-user’s selection of objects displayed on his computer-screen” (col. 1, ll. 37-39).



4. Osga discloses that the “[c]ursor placement anywhere within the region closest to these objects will permit the corresponding object to be selected” (col. 4, ll. 41-43).

#### V. PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Brief to show error in the proffered *prima facie* case. Only those arguments actually made by Appellant has been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief has not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).



Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

## VI. ANALYSIS

### *Grouping of Claims*

In the Brief, Appellant argues claims 1-8 as a group (App. Br. 3). For claims 2-8, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 2-8 as standing or falling with claim 1.

*See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).



*The Board's Claim Construction*

The *claims* measure the invention. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322.

Appellant contends that “MacCuish, Tachibana, and Osga results in a system that fails to have an icon appear at a position selected by a control means when there is an element in a database having a corresponding distance to database elements for which icons are already displayed elsewhere on the display unit.” (App. Br. 4.)

Initially, we note that although Appellant argues that the cited references fail to have an icon appear at a position selected by a control means, we find that the Appellant has chosen to draft the claims, claim 1 in particular, far more broadly.



During patent prosecution, claims are construed as broadly as is reasonable. Hence, we find that the claimed “*wherein the control means selects any arbitrary position on the display unit*” does not positively recite any relationship to the “*the user interface displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity.*”

In other words, we find that claim 1 does not require that the display or removal of an icon is only placed in the arbitrary position selected by the control means.

Thus, the terms of claim 1, under a broad but reasonable interpretation, do not require that the display or removal of an icon be only placed in the arbitrary position selected by the control means.

In addition, we note that while Appellant claims “*wherein the control means selects any arbitrary position on the display unit,*” Appellant also identifies the control means as a slide control 7 (see App. Br. 3, Summary of Claimed Subject Matter). However, Appellant’s Specification specifically states on page 6, lines 8-20 that “a user can now *touch* any arbitrary location 5 on the display.” (emphasis added) Further, Appellant’s Figs. 1-3 clearly illustrates “means” that includes application of a touch screen which are expressly disclosed on page 4, lines 13-14 of the Specification. Thus, we find that Appellant’s contention that the “control means” for selecting an arbitrary position is embodied by the “slide control 7” is at least misdescriptive as the Appellant has failed to show any correspondence



between the function of arbitrary selecting a position on the display and the slide control 7. Therefore, we find that the control means reads on any of a mouse, pen or application of a touch screen as disclosed on page 4 of Appellant's Specification.

### *The Obviousness Rejection*

Appellant contends that “[i]n contrast to disclosing displaying an icon at any arbitrary position on the display unit, Tachibana discloses ‘an icon indicating the root of the first hierarchical level . . . positioned in the center’ and that other icons are positioned relative to this root icon.” (App. Br. 5; Reply Br. 3.) Appellant further contends that “Osga merely discloses a scheme to highlight an object that is closest to the actual cursor placement selected by the user.” (App. Br. 6; Reply Br. 3.)

We first note that Appellant's arguments are not commensurate with the actual scope of instant claim 1. As noted *supra*, while claim 1 requires that the control means selects an arbitrary position on the display, the claim does not require displaying an icon in the selected arbitrary position.

The Examiner relies upon Tachibana and Osga to disclose the above-noted limitations and found that that Tachibana discloses using “control means to select a position on the display unit” (Ans. 4). Particularly, the Examiner finds that Osga discloses “the selection and manipulation of an object on the display based on the selection of an arbitrary position by the user” *Id.* at 4. We agree.



As set forth in the Findings of Facts section, Tachibana's icon display method discloses a step for drawing icons having a correlation with other icons displayed and computing the position of such icons (FF 1-2). Similarly, Osga discloses a method for selecting icons on a display by placing a cursor anywhere within a region (FF 3-4). In our view, these combined teachings fairly and reasonably suggest displaying an icon at any arbitrary position on the display unit.

As to the other recited elements of claim 1, Appellant provides no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Therefore, we do *not* find that Appellant has shown error in the Examiner's rejection of illustrative claim 1. Instead, we find the Examiner has set forth a sufficient initial showing of obviousness. Appellant has not shown that the combination of MacCuish, Tachibana, and Osga lacks the above-noted disputed features of claim 1. Therefore, we affirm the rejection of independent claim 1 and of claims 2-8, which fall therewith.

*No combinability arguments*

We note that Appellant has presented no arguments directed to the combinability of the references MacCuish, Tachibana, and Osga. Accordingly, Appellant has waived any such arguments, and the combinability of such references will not be addressed here.



#### VII. CONCLUSION

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-8.

Thus, claims 1-8 are not patentable.

#### VIII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-8.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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